

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 10, 17, 18 and 22-36, and with the addition herein without prejudice of new claims 37-39, claims 1-9, 11-16, 19-21 and 37-39 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Election

Applicants have canceled without prejudice claims 22-36 that the examiner deemed withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to a nonelected invention.

III. Rejection of Claim 15 Under 35 U.S.C. §112

Applicant has amended claim 15 without prejudice so as to depend from claim 14, thereby providing antecedent basis for the term "the locking mechanism" as noted by the examiner. Applicants respectfully maintain that this claim complies with all of the requirements of 35 U.S.C. §112, second paragraph, and requests that the rejection be withdrawn.

IV. Rejection of Claims 1-3 Under 35 U.S.C. § 102(e)

Claims 1-3 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,547,721 ("Higuma et al."). Applicants respectfully submit that Higuma et al. do not anticipate the present claims for the following reasons.

Claim 1 relates to a flexible shaft. Claim 1 has been amended herein without prejudice to recite that the flexible shaft includes a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture within the outer sheath. Support for this amendment can be found, for instance at page 39, lines 30-32, of the Specification which states that "[m]oisture sensor 990 is coupled to the data transfer cable 38 to communicate an indication of the presence of moisture."

Higuma et al. state that “a moisture absorptive member 158 may be placed in the sealed space.” Col. 26, lines 1-2. Higuma et al. also state that “[t]he moisture absorptive member 158 absorbs invading steam and will thus help prevent deterioration of electronic parts.” Col. 26, lines 2-4. Higuma et al. further state that “[i]f the moisture absorptive member can be replaced with a new one, it would be more advantageous.” Col. 26, lines 4-6.

It is respectfully submitted that Higuma et al. do not anticipate claim 1 for at least the reason that Higuma et al. do not describe all of the features recited in claim 1. For example, Higuma et al. do not describe a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture as recited in claim 1. The Specification states at page 39, lines 30-32, that “[m]oisture sensor 990 is coupled to the data transfer cable 38 to communicate an indication of the presence of moisture (e.g., sensed moisture data is communicated) to the remote power console 12.” The Specification also states at page 40, lines 1-4, that “[i]n accordance with and/or based on the sensed moisture data, the remote power console 12 may communicate the presence of moisture to a user, such as, for example, by audible or visual signal” The Specification also states at page 39, line 32 – page 40, line 1, that “[t]he presence of moisture within the flexible shaft 20 may cause corrosion of the components of the flexible shaft 20, such as, for example, the rotatable drive shafts 30, 32, electronic or electrical components arranged in the flexible shaft 20, etc.”

Higuma et al., on the other hand, describe at page 26, lines 2-4, that “[t]he moisture absorptive member 158 absorbs invading steam and will thus help prevent deterioration of electronic parts.” Col. 26, lines 2-4, emphasis added. Thus, Higuma et al. describe that moisture in the device is absorbed, not that the presence of moisture is communicated.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566

(Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Higuma et al. does not anticipate claim 1, because Higuma et al. describe a moisture absorptive member that absorbs invading steam, not a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture as recited in claim 1.

As for claims 2-3, each of which ultimately depend from and include all of the limitations of independent claim 1, it is respectfully submitted that Higuma et al. do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

V. Rejection of Claims 7-9, 11-16 and 19 Under 35 U.S.C. § 103(a)

Claims 7-9, 11-16 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuma et al. in view of U.S. Patent No. 6,071,233 ("Ishikawa et al."). It is respectfully submitted that the combination of Higuma et al. and Ishikawa et al. does not render obvious the present claims herein for the following reasons.

Claim 11 relates to a surgical system. Claim 11 has been amended herein without prejudice to recite a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture. Support for this amendment is set forth above in connection with the amendments made to claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is respectfully submitted that the combination of Higuma et al. and Ishikawa et al. does not render unpatentable claim 7-9 for at least the reason that the

combination of Higuma et al. and Ishikawa et al. does not describe all of the features recited in claims 7-9. As set forth above, Higuma et al. describe a moisture absorptive member that absorbs invading steam, not a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture as recited in claim 1. This feature of claim 1 is also not described in Ishikawa et al. Since claims 7-9 depend from claim 1, and therefore include all of the limitations of claim 1, the combination of Higuma et al. and Ishikawa et al. do not describe all of the features of claims 7-9. For at least this reason, it is respectfully maintained that claims 7-9 are not rendered unpatentable by the combination of Higuma et al. and Ishikawa et al.

Also, it is respectfully submitted that the combination of Higuma et al. and Ishikawa et al. does not render unpatentable claim 11 for at least the reason that the combination of Higuma et al. and Ishikawa et al. does not describe all of the features recited in claim 11. For the same reasons as set forth above, it is respectfully maintained that neither Higuma et al. and Ishikawa et al. describe a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture.

As for claims 12-16 and 19, which depend from claim 11 and therefore include all of the features of claim 11, it is respectfully submitted that the combination of Higuma et al. and Ishikawa et al. does not render unpatentable these dependent claims for at least the same reasons given above in support of the patentability of claim 11. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 4-6 and 20-21 Under 35 U.S.C. § 103(a)

Claims 4-6 and 20-21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Higuma et al. in view of Ishikawa et al. and further in view of U.S. Patent No. 6,547,721 ("Abe"). Applicants respectfully submit that the combination of Higuma et al., Ishikawa et al. and Abe does not render unpatentable the present claims for at least the following reasons.

It is respectfully submitted that the combination of Higuma et al., Ishikawa et al. and Abe does not render unpatentable claims 4-6 and 20-21 for at

least the reason that the combination of Higuma et al., Ishikawa et al. and Abe does not describe all of the features recited in their respective independent claims 1 and 11. As set forth above, neither Higuma et al. nor Ishikawa et al. describe a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture as recited in claims 1 and 11. Abe is not relied on to disclose or suggest, and in fact does not disclose or suggest, that feature of claim 1 that is not described by Higuma et al. and Ishikawa et al. Rather, Abe purports to relate to an electronic endoscope system that enables different types of endoscopes to be used and makes no mention whatsoever of a moisture sensor disposed within the outer sheath configured to communicate the presence of moisture. Since claims 4-6 and 20-21 depend from respective ones of independent claims 1 and 11, and therefore includes all of the limitations of respective ones of independent claims 1 and 11, the combination of Higuma et al., Ishikawa et al. and Abe does not describe all of the features of claims 4-6 and 20-21. For at least this reason, it is respectfully maintained that claims 4-6 and 20-21 are not rendered unpatentable by the combination of Higuma et al., Ishikawa et al. and Abe.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Allowable Subject Matter

Applicant gratefully acknowledges the indication that claims 10, 17 and 18 would be allowable if rewritten in independent format. Applicants have canceled claims 10, 17 and 18 without prejudice herein and have added new claims 37-39 which include all of the limitations recited in claims 10, 17 and 18, respectively. Applicants respectfully submit that these new claims are in condition for immediate allowance.

VIII. Conclusion

Applicant respectfully submits that the pending claims are in condition for allowance and requests that such action be taken. If for any reason the Examiner believes that prosecution of this application would be advanced by contact with the

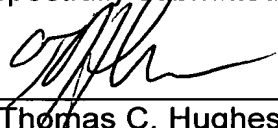
Applicant's attorney, the Examiner is invited to contact the undersigned at the telephone number given below.

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The Commissioner is authorized to charge any necessary fees or credit any overpayments under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: Oct. 28, 2005

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